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EXAMINER
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WASEL, MOHAMED A

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SANTOSH S. RAO, GOPAL SHARMA,  
and POONAM P. DHAVALE

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Appeal 2008-0258  
Application 10/627,385  
Technology Center 2100

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Decided: August 12, 2008

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Before JAMES D. THOMAS, LANCE LEONARD BARRY, and  
STEPHEN C. SIU, *Administrative Patent Judges*.

BARRY, *Administrative Patent Judge*.

ORDER REQUIRING APPELLANTS TO BRIEF AN  
ADDITIONAL MATTER

A Patent Examiner rejected claims 1-31. The Appellants appeal therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b) and exercise our jurisdiction to address an issue.

## II. AUTHORITIES

When the Appellants filed their *Replacement Appeal Brief under 37 C.F.R. § 41.37*, such a brief was required to include the following contents.

A concise explanation of the subject matter defined in each of the independent claims involved in the appeal, which shall refer to the specification by page and line number, *and to the drawing, if any, by reference characters*. For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, *and to the drawing, if any, by reference characters*.

37 C.F.R. § 41.37(c)(1)(v) (2006) (emphases added).<sup>1</sup> "Because it enables the Board to more quickly determine where the claimed subject matter is described in a patent application, reference to such characters is always important." *Ex parte Nelson*, No. 2007-3534, 2008 WL 1957935 (BPAI 2008).

## III. ANALYSIS

Here, "the invention as set forth by independent claim 1 relates to a method" (Replacement Br. 2), which comprises steps. In describing the method, although the Appellants' *Summary of Claimed Subject Matter* refers

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<sup>1</sup> We cite to the version of the Code of Federal Regulations in effect when the Appellants filed their *Brief of Appellant*. The current version includes the same rules.

to four of the Appellants' figures (*id.*), which collectively comprise fifty-five reference characters, it mentions only one of those reference characters. Of the four figures, "Figure 8 is a *flow chart* illustrating cluster membership change techniques of the present invention" (Spec. 7 (emphasis added)), and "Figure 9 is a *flow chart* illustrating fencing techniques of the present invention." (*Id.* (emphasis added).) These flow charts collectively comprise twenty-six blocks. The Appellants' *Summary*, however, fails to map the method steps of claim 1 to the blocks of the flow charts. From our review of the Figures, we do not find a one-to-one correspondence of the claimed method steps to the blocks of the Figures.

"The invention as set forth by independent claim 15 relates to a system" (Replacement Br. 2), which includes "a first memory and a first processor configured to provide a coordinator virtual device" and "a second memory and a second processor . . . ." The Appellants' *Summary*, however, fails to map these elements to the Appellants' Figures. Claim 15 also includes steps to "detect when the computer system cluster is partitioned[.]" "attempt to gain control of the coordinator virtual device corresponding to at least a portion of the first data storage device[.]" and "remove the at least one of the plurality of virtual device configuration clients from the computer system cluster when the attempt to gain control of the coordinator virtual device is unsuccessful." The *Summary* also fails to map these steps to the blocks of the Appellants' aforementioned flow charts.

"The invention as set forth by independent claim 28 relates to an apparatus." (Replacement Br. 3.) As noted by the Appellants, "[t]he

apparatus includes a means for providing a coordinator virtual device corresponding to at least a portion of *a physical data storage device*." (*Id.* 3-4 (emphasis added).) "A means for detecting when a computer system cluster, including *a plurality of nodes*, is partitioned is also included." (*Id.* 4 (emphasis added).) The Appellants' *Summary*, however, fails to map the physical data storage device or the nodes to the Appellants' figures.

#### IV. CONCLUSION

Because of the aforementioned omissions, we are persuaded that "[t]he appeal is manifestly not ready for a decision on the merits." *Ex parte Braeken*, 54 USPQ2d 1110, 1112 (BPAI 1999).

#### V. ORDER

"We decline to substitute our speculation for the greater certainty that should come from the Appellants." *Ex Parte Dietz*, No. 2007-2386, 2008 WL 696147, at \*2 (BPAI 2008). More specifically, the Appellants must submit a substitute *Summary of Claimed Subject Matter*. The substitute *Summary* shall include the following features:

- a mapping of each of the four steps of claim 1 to the corresponding, individual steps of Figures 8 and 9;
- a mapping of "a first memory and a first processor configured to provide a coordinator virtual device" and "a second memory and a second processor" of claim 15 to the corresponding reference characters of the Appellants' figures;
- a mapping of each of the last three steps of claim 15 to the corresponding, individual steps of Figures 8 and 9;

- a mapping of "a physical data storage device" and "a plurality of nodes" of claim 28 to the corresponding reference characters of the Appellants' figures.

Under 37 C.F.R. § 41.50(d), we give the Appellants a non-extendable time period of thirty days within which to respond to this order. Failure to comply with the order within that time may result in the *sua sponte* dismissal of this appeal. 37 C.F.R. § 41.50(d).

No time for taking any action connected with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

ORDERED; 37 C.F.R. § 41.50(d)

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